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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/587,249	06/02/2000	Seishiro Yoshioka	35.C5745 CIP/C2/D2/REI	6842

5514 7590 02/12/2002

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NEW YORK, NY 10112

EXAMINER

RAMSEY, KENNETH J

ART UNIT	PAPER NUMBER
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2879

DATE MAILED: 02/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,249

Applicant(s)

YOSHIOKA ET AL.

Examiner

Kenneth J. Ramsey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11,12,15,16,18-43,45 and 49-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) (all pending claims) is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

Identification of Error in Reissue Declaration

1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Merely stating that claims 5-42 should have been presented for examination is not sufficient, since it does identify the claim limitation(s) of the original claims that results in applicants claiming less than they had a right to claim. The declaration points to no limitation or limitations in the patent claims that constitutes an error by way of claiming less than applicants had a right to claim in the patent.

2. Claims 1 through 42 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Response to Arguments

1. The applicants' arguments and amendments have resulted in the removal of all but one ground of rejection, which is that the reissue declaration does not identify the error which results in applicants claiming less than they had a right to claim.

3. Applicant's arguments as to the above ground of rejection, filed October 3, 2001, have been fully considered but they are not persuasive. The examiner holds that merely stating that claims should have been presented in the original patent does not constitute identification of an error which would constitute a basis for reissue.

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4. The above is based upon the following language of MPEP 1414 "It is not sufficient for an oath/declaration to merely state "this application is being filed to correct errors in the patent which may be noted from the changes made in the disclosure." Rather, the oath/declaration must specifically identify an error. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error" (emphasis added). Since applicants state that they claimed less than they had a right to claim, applicants must point out the error in the original claims compared to the new claims that is relied upon.

5. The following acceptable language was in a proposed declaration faxed by applicant's attorney on January 9, 2002 : "Our U.S. Patent 5,759,080 correctly claims some aspects of our invention, namely a method of preparing an electron-emitting device as defined in Claims 1-5 of that patent, but does not claim other aspects to which we are entitled. In particular, Claims 1 and 2 of our U.S. Patent 5,759,080 recite, in part, 'etching the insulating layer so as to partially expose the fine particles' and 'etching the semiconductor layer so as to partially expose the fine particles', respectively, and Claims 3-5 of our U.S. Patent 5,759,080 each recite, in part, 'dispersing fine particles between said electrodes'. One of the errors in our U.S. Patent 5,759,080 is that none of those original claims provides patent protection for a broader aspect of the present invention not requiring those steps, such as a method of fabricating an electron-emitting

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device which comprises a pair of electrodes and a layer disposed between the electrodes, the method comprising the steps of disposing the pair of electrodes in first and second regions on a substrate, respectively, and providing the layer between the regions, the layer comprising a metal and a semiconductor, wherein the metal is Pd. This aspect of the invention is set forth in Claim 6, which has been added in the present reissue application. Therefore, our U.S. Patent 5,759,080 does not give our invention adequate protection.

Accordingly, I believe that the failure of our U.S. Patent 5,759,080 to provide adequate protection for the aspect of our invention discussed above and set forth in Claim 6 renders the patent partly inoperative for the reason that we claimed less than we had the right to claim in the patent.

I hereby declare and say that every error in the patent which was corrected in the present reissue application, and which is not covered by the prior oaths) and/or declaration(s) submitted in this application, arose without any deceptive intention on my part."

As of February 11, 2002, applicants have not submitted the above declaration.

Action Made Final

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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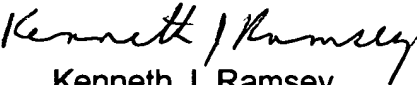
mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Directions for Responses

Any formal response to this communication should be directed to examiner Kenneth Ramsey, Art Unit 2879, and either

faxed to: 703-872-9319; or mailed to: Box AF
Assistant Commissioner For Patents
Washington, D.C. 20231

Technical inquiries concerning this communication should be directed to Kenneth J. Ramsey, (703) 308-2324 (voice), (703) 746-4832 (fax). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Kenneth J. Ramsey
Primary Examiner
Art Unit 2879

kjr
February 11, 2002